

Application No. 10/085,543
Amendment date: June 3, 2004
Amendment to Office Action of March 11, 2004
Express Mail No. EL 978301008 US

REMARKS/ARGUMENTS

I. Claim Rejections 35 USC § 112

Claims 3-5, 8-10, and 14 -16 were rejected by the examiner as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 has been amended to indicate “the vertical portion” as the Examiner suggested.

Claims 3-5 have been amended so that they do not include a cable.

Claims 8-10 and 14-16 have been amended to specifically include a cable.

Applicant believes the above amendments make the claims definite.

II. Claim Rejection 35 USC § 103

Claims 3-5, 8-10, and 14-16 have been rejected by the Examiner under 35 U.S.C. 103 (a) as being unpatentable over Redman et al (US Patent No. 4,550,890) (“Redman”) in view of Nelson (US Patent No. 3,069,738) (“Nelson”) or Sword (US Patent No. 4,653,791) (“Sword”) and further in view of Arakawa (US Patent No. 4,656,698) (“Arakawa”).

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143.

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The Examiner contends, “[t]o support pipes via straps or cables are notoriously old and well-known in the art. Straps and cables are well known obvious mechanical equivalents for suspending objects” (Page 3, ls. 20-21, March 11, 2004 Office Action.). The Examiner also states, “It would have been obvious to one of ordinary skill in the art to modify the strap and strap retention assembly of Redman such that the strap is substituted with a cable for the reason that straps and cable suspension support are well known mechanical equivalents as demonstrated by both Nelson and Sword, and consequently substituting the strap retention wedge system of Redman for a cable retention wedge system as taught by Arakawa. Such modification would have involved a mere substitution of one well known flexible suspension device from another and consequently modifying the strap retaining device to a cable retaining device. (Page 4 ls.15-22, March 11, 2004 Office Action).

The Examiner is incorrect that Nelson and Sword demonstrate that straps and cable suspension supports are well known mechanical equivalents. Neither Nelson nor Sword indicates that cables can be used instead of straps or that it is desirable to use a cable in place of a strap. Neither Nelson nor Sword mentions a strap. In fact it does not appear that the strap in Redman could hold the objects in Nelson or Sword and therefore the strap in Redman is not equivalent to the cables in Nelson and Sword.

While the use of cable for suspending objects is old, there has been no shown motivation to use the cable in Nelson or Sword in combination with a generally “C” shaped clamp in Redman. A new combination of old subject matter is patentable. *Rosemount, Inc. v. Beckman Instruments, Inc.* 727 F.2d 1540 (Fed. Cir. 1984). “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious

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unless the prior art suggested the desirability of the modification.” In re *Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992); 1992 U.S. App. Lexis 18470; 23 U.S.P.Q. 2D (BNA) 1780 (emphasis added). “A statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill of the art at the time the claimed invention was made’ because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references”. MPEP § 2143 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

The Examiner has not shown the desirability of replacing the straps that are used in connection with the C clamp in Redman with the cables shown in Nelson or Sword. It is not just a matter of replacing straps with cables. If one wanted to replace Redman’s straps with Nelson’s or Sword’s cables, Redman’s structure would not work to hold cables. Redman’s straps also use a different object holding means than the object holding means taught by Nelson or Sword. The object holding means are not compatible and are not equivalent with each other. The Examiner has failed to show how it would be desirable or the motivation or suggestion to replace the object holding means in Redman with that of Nelson or Sword which is necessary to reject claims 8-10 and 14-16 (which claim object holding means). The fact that cables and straps are old has nothing to do with the motivation to use the cables in Nelson or Sword with Redman. The Examiner has not shown that it is desirable to replace the straps in Redman with the cables in Nelson or Sword with the object holding means in Nelson or Sword.

The Examiner also states it would be obvious to replace the Redman’s retention structure with the retention structure in Arakawa. However, there is no motivation in Redman or Arakawa

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to suggest the desirability of such replacement. Arakawa is used for a totally different purpose. Arakawa teaches an apparatus for holding one end of a wire to a first support structure and the other end of the wire to a second support structure. Figures 5-8 show a wire supported in two separate locations and Column 4, lines 39-68, discusses how to use the apparatus to secure the wire (w) to two support locations.

There is no suggestion or motivation to take a device that holds one end of a wire and is to be used on two support structures (Arakawa '698) and to incorporate it into a device that uses both ends of a strap from 1 support structure. The only motivation to make this combination is Applicant's claim.

The Declaration of Jim Moon, an expert in the field, is being submitted. Mr. Moon's declaration indicates that the claimed invention is not obvious because there is no motivation to combine the art.

The Examiner has used the Applicant's claimed invention as a blueprint and has combined references without any teaching or motivation to do so. It is well established law that it is improper to use Applicant's claims as a blueprint and to reconstruct the invention from the prior art using the claim as a blueprint. *Grain Processing Corp. v. American Maize Products Corp.* 840 F.2d 902 (Fed.Cir.1988); *Smith Kline Diagnostics Inc. v. Helena Laboratories Corp.* 859 F.2d. 878 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d. 751 (Fed. Cir. 1987); *In re Dow Chemical*, 837 F.2d. 469 (Fed. Cir. 1988); *Northern Telecom, Inc. v. Datapointe Corp.* 908 F.2d. 931; (Fed. Cir. 1990), *cert. denied*, 11 S.Ct.296 (1990); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

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Claims 3-5, 8-10 and 14-16 are rejected under 35 U.S.C. 103(a) and 14-16 have been rejected by the under 35 U.S.C. 103(a) as being unpatentable over Hirt (US Patent No. 3,321,161) ("Hirt") in view of Nelson or Sword and further in view of Arakawa.

The Examiner has again failed to provide any suggesting or teaching to modify the prior art and therefore has not established a *prima facie* case of obviousness. MPEP § 2143. The Examiner states, "It would have been obvious to one of ordinary skill in the art to modify the strap and rod retention assembly of Hirt such that the rod is substituted with a cable since cable suspension support are old and well-known."

Just because rod and cable supports are old and well known does not mean that there is motivation to combine Hirt and Nelson or Sword. "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references". MPEP § 2143 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

There is no motivation or desirability that suggests replacing the rod in Hirt with the cable in Nelson or Sword. And even if one wanted to replace the rods with cables Hirt's structure will not work to hold cables. Additionally, there is no suggestion to replace the object holding means in Hirt with the object holding means in Sword or Nelson.

The Examiner also suggests that it would be obvious to replace Hirt's retention structure with the retention structure in Arakawa. However, there is no motivation in Hirt or Arakawa to

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suggest the desirability of such replacement. Arakawa is used for a totally different purpose. Arakawa '698 teaches an apparatus for holding one end of a wire to a first support structure and the other end of the wire to second support structure. Figures 5-8 show a wire supported in two separate locations and Column 4 lines 39-68 discusses how to use the apparatus to secure the wire (w) to two support locations.

There is no suggestion or motivation to take a device that holds one end of a wire and is to be used on two support structures (Arakawa '698) and to incorporate it into a device that uses a rod with a carry strap to support a pipe from one location. The only motivation to make this combination is Applicant's claim.

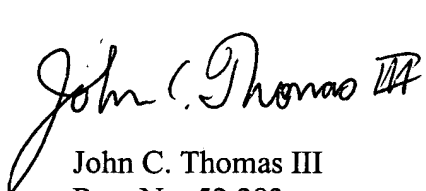
The Declaration of Jim Moon, an expert in the field, is being submitted. Mr. Moon's declaration indicates that the claimed invention is not obvious because there is no motivation to combine the art.

The Examiner has used the Applicant's claimed invention as a blueprint and has combined references without any teaching or motivation to do so. It is well established law that it is improper to use Applicant's claims as a blueprint and to reconstruct the invention from the prior art using the claim as a blueprint. *Grain Processing Corp. v. American Maize Products Corp.* 840 F.2d 902 (Fed.Cir.1988); *Smith Kline Diagnostics Inc. v. Helena Laboratories Corp.* 859 F.2d. 878 (Fed. Cir. 1988); *In re Stencel*, 828 F.2d. 751 (Fed. Cir. 1987); *In re Dow Chemical*, 837 F.2d. 469 (Fed. Cir. 1988); *Northern Telecom, Inc. v. Datapointe Corp.* 908 F.2d. 931; (Fed. Cir. 1990), *cert. denied*, 11 S.Ct.296 (1990); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132 (Fed. Cir. 1985).

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One cannot use Applicant's claim as a blueprint to achieve the Applicant's combination by finding various component parts of Applicant's claim in different pieces of art. There must be some suggestion or motivation in the art to suggest combining the various features of the prior art. *Fritch* 972 F. 2d 1260.

Respectfully submitted,

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